# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 09/594,302 | 06/14/2000 | Craig William Payne | PHCM.P0026 | 7726 |

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| EXAMINER |
|---|
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| 2682 | |

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | Application No. | Applicant(s) |
|---|---|---|---|
| | | 09/594,302 | PAYNE ET AL. |
| **Office Action Summary** | | Examiner | Art Unit | |
| | | David Q Nguyen | 2682 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *14 June 2000* .

2a)☐ This action is **FINAL**.          2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-46* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)          4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)     5)☐ Notice of Informal Patent Application (PTO-152)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .     6)☐ Other: .

## DETAILED ACTION

### *Claim Objections*

1.      Claim 18 is objected to because of the following informalities:

In claim 37, "A wireless communication device as described in claim **30**" should be

changed to "A wireless communication device as described in claim **36**".

Correction is required.

### *Claim Rejections - 35 USC § 102*

(e) the invention was described in a patent granted on an application for patent by another filed in the United
States before the invention thereof by the applicant for patent, or on an international application by another who
has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b).  Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment

by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2.      Claims 1-4, 7, 12-14, 16-18, 23-25, 28, 33-36, 39, and 44-46 are rejected under 35

U.S.C. 102(e) as being anticipated by Ishikawa et al. (US Patent Number 6466782).

Regarding claim 1, Ishikawa disclose a method for operating a wireless communication

device having a display screen and a user interface, comprising: automatically finding one or

more contact identifiers belonging to predetermined classes within a message entity; and

displaying on the display screen of the wireless communications device descriptive information relating to the found contact identifiers (see abstract and fig. 7).

Regarding claim 23, Ishikawa disclose a computer readable medium on which is encoded computer program code for providing a display on the display screen of a wireless communication device, comprising computer program code for finding contact identifiers belonging to predetermined classes within a message entity; and computer program code for generating a screen display presentation relating to the found contact identifiers belonging to pre-determined classes (see abstract and fig. 7).

Regarding claim 35, Ishikawa disclose a wireless communication device having a display screen and a user interface, comprising a storage device for storing message entities; a memory for storing program code for a processor; and a processor coupled to the storage device and the memory, wherein the processor operates to execute the program code stored in the memory to find contact identifiers belonging to predetermined classes of contact identifiers in the message entities stored on the storage device and display descriptive information on the display screen relating to the found contact identifiers (see col. 3, lines 42-67; col. 4, lines 1-54; see fig. 1, fig. 5, fig. 6, fig. 7).

Regarding claims 2 and 36, Ishikawa disclose a method for operating a wireless communication device and a wireless communication device having a display screen and a user interface, comprising all of the limitations as claimed. Ishikawa also disclose wherein the message entity is comprised of the headers and content of the text based message (see fig. 7)

Regarding claim 3, Ishikawa disclose a method for operating a wireless communication device having a display screen and a user interface, comprising all of the limitations as claimed.

Ishikawa also disclose wherein the text-based message is stored on the wireless communication device (see fig. 4; col. 4, lines 3-13).

Regarding claim 4, Ishikawa disclose a method for operating a wireless communication device having a display screen and a user interface, comprising all of the limitations as claimed. Ishikawa also disclose wherein the text-based message is being processed by the wireless communication device (see abstract; col. 4, lines 3-13; fig. 4).

Regarding claims 7, 28, and 39, Ishikawa disclose a method for operating a wireless communication device, a wireless communication device having a display screen and a user interface and a computer readable medium on which is encoded computer program code for providing a display on the display screen of a wireless communication device, comprising all of the limitation as claimed. Ishikawa also disclose, comprising all of the limitations as claimed. Ishikawa also disclose wherein the predetermined classes of contact identifiers are selected from a group consisting of electronic mail contact identifiers, Uniform Resource Indicators (URIs), phone number contact identifiers, facsimile number contact identifiers, pager number contact identifiers, SMS contact identifiers and user specified contact identifiers (see col. 3, lines 59-61; col. 4, lines 14-54; fig. 5).

Regarding claims 12-13 and 44-45, Ishikawa disclose a method for operating a wireless communication device, and a wireless communication device having a display screen and a user interface, comprising all of the limitations as claimed. Ishikawa also show wherein the descriptive information relating to found contact identifiers includes a symbolic information indicator; wherein the symbolic information indicator is an icon (see fig. 7).

Regarding claim 14, Ishikawa disclose a method for operating a wireless communication device having a display screen and a user interface, comprising all of the limitations as claimed. Ishikawa also disclose associating a found contact identifier with one of a plurality of association services accessible through the wireless communication device; and utilizing the found contact identifier to setup a communication link for the associated communication service accessible through the wireless communication device (see abstract; col. 3, lines 59-61; col. 4, lines 34-54; fig. 3).

Regarding claim 16, Ishikawa disclose a method for operating a wireless communication device having a display screen and a user interface, comprising all of the limitations as claimed. Ishikawa also show identifying resources containing found contact identifiers; and retrieving the identified resources (see fig. 5; col. 3, lines 59-61; col. 4, lines 14-54).

Regarding claims 17-18, Ishikawa disclose a method for operating a wireless communication device having a display screen and a user interface, comprising all of the limitations as claimed. Ishikawa also disclose wherein the wireless communication device incorporates a microprocessor and storage area for program code; wherein the microprocessor utilizes the program stored in the storage area to control a phone function and a local application ' (see col. 3, lines 35-41; col. 4, lines 3-42; fig. 1).

Regarding claims 24, Ishikawa disclose a computer readable medium on which is encoded computer program code for providing a display on the display screen of a wireless communication device, comprising all of the limitation as claimed. Ishikawa also disclose computer code for displaying symbolic identifiers relating to the function of found contact identifiers belonging to predetermined classes (see fig. 7)

Regarding claim 25, Ishikawa disclose a computer readable medium on which is encoded computer program code for providing a display on the display screen of a wireless communication device, comprising all of the limitation as claimed. Ishikawa also disclose wherein the message entity is comprised of the headers and content of the text based message (see fig. 7).

Regarding claims 33-34, Ishikawa disclose a computer readable medium on which is encoded computer program code for providing a display on the display screen of a wireless communication device, comprising all of the limitation as claimed. Ishikawa also disclose wherein the screen display presentation includes symbolic information identifiers; and the symbolic identifiers are icons (see fig. 7).

Regarding claim 46, Ishikawa disclose a wireless communication device having a display screen and a user interface, comprising all of the limitations as claimed. Ishikawa also disclose program code stored in the memory for associating a found contact identifier with one of a plurality of association services accessible through the wireless communication device; and program code stored in the memory for utilizing the found contact identifier to setup a communication link for the associated communication service accessible through the wireless communication device (see abstract; col. 3, lines 36-67; col. 4, lines 1-54; fig. 1. fig. 3, fig. 5, fig. 6, fig. 7).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.      Claims 5-6, 15, 26-27 and 37-38 are rejected under 35 U.S.C. 103(a) as being

unpatentable over by Ishikawa et al. (US Patent Number 6466782) in view of Dahm et al. (US

Patent Number 6301471).

Regarding claims 5-6, and 26-27, Ishikawa disclose a method for operating a wireless

communication device, a wireless communication device having a display screen, and a user

interface; and a computer readable medium on which is encoded computer program code for

providing a display on the display screen of a wireless communication device, comprising all of

the limitation as claimed. Ishikawa also disclose. Ishikawa are silent to disclose wherein the

message entity is markup language file; the markup language file is selected from the group

consisting of Handheld Device Markup Language (HDML); Wireless Markup Language

(WML), Hypertext Markup Language (HTML); Compact Hypertext Markup Language

(cHTML), and Extensible Markup Language (XML). However, Dahm disclose the message

entity is a markup language file; the markup language file is selected from the group consisting

of Handheld Device Markup Language (HDML), Wireless Markup Language (WML), Hypertext

Markup Language (HTML); Compact Hypertext Markup Language (cHTML), and Extensible

Markup Language (XML) (see abstract; fig. 1; col. 5, lines 22-53). Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to provide the

above teaching of Dahm to Ishikawa so that a network server device is capable of including a

connection mechanism between wireless carrier network and wired network.

Regarding claim 15, Ishikawa disclose a method for operating a wireless communication

device having a display screen and a user interface, comprising all of the limitations as claimed.

Ishikawa are silent to disclose wherein the communication services accessible through the

wireless communication device are selected from a group consisting of electronic mail services,

facsimile services, short message services, paging services, file retrieval services and phone

services. However, Dahm show the communication services accessible through the wireless

communication device are selected from a group consisting of electronic mail services, facsimile

services, short message services, paging services, file retrieval services and phone services (see

abstract and fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to provide the above teaching of Dahm to Ishikawa to improve

the user friendliness of wireless communication.

Regarding claim 37-38, Ishikawa disclose a wireless communication device having a

display screen and a user interface, comprising all of the limitation as claimed. Ishikawa are

silent to disclose wherein the text-based message are markup language files; the markup

language file is selected from the group consisting of Handheld Device Markup Language

(HDML); Wireless Markup Language (WML), Hypertext Markup Language (HTML); Compact

Hypertext Markup Language (cHTML), and Extensible Markup Language (XML). However,

Dahm disclose the text-based message are markup language files; the markup language file is

selected from the group consisting of Handheld Device Markup Language (HDML), Wireless

Markup Language (WML), Hypertext Markup Language (HTML); Compact Hypertext Markup

Language (cHTML), and Extensible Markup Language (XML) (see abstract; fig. 1; col. 5, lines 22-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Dahm to Ishikawa so that a network server device is capable of including a connection mechanism between wireless carrier network and wired network.

4.      Claims 8-11, 19-22, 29-32 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Ishikawa et al. (US Patent Number 6466782) in view of Gershman et al. (US Patent Number 6401085).

Regarding claims 8-11, 29-32 and 40-43, Ishikawa disclose a method for operating a wireless communication device, a wireless communication device having a display screen and a user interface; and a computer readable medium on which is encoded computer program code for providing a display on the display screen of a wireless communication device, comprising all of the limitations as claimed. Ishikawa are silent to disclose wherein the user specified contact identifiers are field entries in a file stored in association with a unique identifier for the user of the wireless communication device; wherein the file stored in association with a unique identifier for the user of the wireless communication device is selected from a group consisting of an address book, a calendar and a contact list; wherein the user specified contact identifiers are field entries in a database stored on a remote server device; and wherein the database stored on the remote server device is a public commercial database. However, Gershman disclose wherein the user specified contact identifiers are field entries in a file stored in association with a unique

identifier for the user of the wireless communication device; wherein the file stored in

association with a unique identifier for the user of the wireless communication device is selected

from a group consisting of an address book, a calendar and a contact list; wherein the user

specified contact identifiers are field entries in a database stored on a remote server device; and

wherein the database stored on the remote server device is a public commercial database (see col.

43; lines 46-60; col. 44, lines 1-35). Therefore, it would have been obvious to one of ordinary

skill in the art at the time the invention was made to provide the above teaching of Gershman to

Ishikawa so that a network server device is capable of including a connection mechanism

between wireless carrier network and wired network.

Regarding claims 19-21, Ishikawa disclose a method for operating a wireless

communication device having a display screen and a user interface, comprising all of the

limitations as claimed. Ishikawa are silent to disclose wherein the local application is an address

book application; calendar application; a contact list. However, Gershman disclose wherein the

local application is an address book application; calendar application; a contact list (see col. 43;

lines 45-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to provide the above teaching of Gershman to Ishikawa so that the

wireless communication device should be easy to use in the environment and under the

conditions in which consumers find themselves desiring to use the device.

Regarding claim 22, Ishikawa disclose a method for operating a wireless communication

device having a display screen and a user interface, comprising all of the limitations as claimed.

Ishikawa are silent to disclose wherein the wireless communication device is selected from a

group consisting of a mobile phone, a personal digital assistant, and a two-way pager. However,

Gershman disclose wherein the wireless communication device is selected from a group

consisting of a mobile phone, a personal digital assistant, and a two-way pager (see abstract; and

col. 43; lines 45-60). Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to provide the above teaching of Gershman to Ishikawa so that

the wireless communication device should be easy to use in the environment and under the

conditions in which consumers find themselves desiring to use the device.

### *Conclusion*

5.    The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Any inquiry concerning this communication or earlier communication from the examiner

should be directed to Nguyen Q. David whose telephone number is (703) 605-4254. The

examiner can be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Vivian Chin can be reached on (703)308-6739. The fax numbers for the organization

where this application or proceeding is assigned are (703) 872-9314 for all communications

*DN*
David Q. Nguyen

10/19/02

**NGUYEN T. VO**
**PRIMARY EXAMINER**